

REMARKS

The Office Action mailed November 2, 2007, has been received and reviewed. New claims 29-36 have been added. Claims 18-28 were withdrawn from consideration as being drawn to a non-elected invention, and have been canceled. Applicant herein acknowledges the restriction requirement in the above-referenced application, and affirm the election to prosecute the claims of Group I, claims 1-17, without further traverse. Claims 1-17 and 29-36 are currently pending in the application. Claims 1-6, 8, 9 and 12-17 stand rejected. Claims 7, 10 and 11 are objected to. Applicant has amended claims 1, 5, 6, 13 and 17, and respectfully request reconsideration of the application as amended herein.

Support for Applicant's amendments is found in Applicant's as-filed specification in at least paragraphs [0033-0036] and [0041-0042]. No new matter has been added.

35 U.S.C. § 103 Obviousness Rejections

Claims 1-6, 8-9 and 12-17 were rejected as being unpatentable over U.S. Patent 6,901,062 to Scherzer et al (hereinafter "Scherzer") in view of U.S. Patent 6,424,631 to Czaja et al (hereinafter "Czaja"). Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, "[a] patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art . . . it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben*

GmbH & Co. Deutschland KG v. C. H. Patrick Co., 464 F.3d 1356, 1367 (Fed. Cir. 2006);

MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-6, 8-9 and 12-17 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claims limitations.

Applicant respectfully asserts that each of Applicant's independent claims 1, 6, and 17 including new independent claims 29 and 34, recites in part, a "*plurality of orthogonal codes for supplemental traffic channels*". Furthermore, neither Scherzer nor Czaja teach or suggest supplemental traffic channels. Therefore, since neither Scherzer nor Czaja teach or suggest "supplemental traffic channels," these references, either individually or in any proper combination, cannot teach or suggest a "plurality of orthogonal codes" for elements, namely "supplemental traffic channels," that are neither taught nor suggested.

Therefore, since neither Scherzer nor Czaja teach or suggest Applicant's claimed invention including a "*plurality of orthogonal codes for supplemental traffic channels*", these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicant's invention as presently claimed in independent claims 1, 6, and 17 including new independent claims 29 and 34. Accordingly, Applicant respectfully requests the rejection of independent claims 1, 6 and 17 be withdrawn.

The nonobviousness of independent claims 1 and 6 precludes a rejection of claims 2-5 and 7-16 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1 and 6 and claims 2-5 and 7-16 which respectively depend therefrom.

Objections to Claims 7, 10 and 11/Allowable Subject Matter

Claims 7, 10 and 11 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. Applicant acknowledges this indication with appreciation, but respectfully asserts that the claims in their present form, along with all other claims presently under consideration, are in condition for allowance.

CONCLUSION

Claims 1-17 and 29-36 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

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